separated into different groups. Furthermore, dependent claim 24 is in a separate group from independent claim 22.

The Office Action maintains the restriction requirement is proper because the kit of claim 24 can be used in a materially distinct process such as treating wounds. This statement, however, is merely conclusory and does not meet the *prima facie* requirement for demonstrating that either the claims are in a separate classification, separate status in the art, or a different field of search. MPEP 803 (8th Ed. 2001). In fact, claim 24 is classified within the same class and subclass as claims 22 and 23. This is important because where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. MPEP 806.03. As claim 24 is dependent upon claim 22 or 23, the Office Action is hard pressed to suggest a separate utility.

So what

Applicants respectfully remind the Examiner that every requirement to restrict has two aspects: (a) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween. MPEP 808 (8th Ed. 2001). The particular reasons relied on by the Examiner for holding that inventions as claimed are independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. MPEP 816 (8th Ed. 2001).

The claims are directed to a method for enhancing the effective of nicotine replacement therapy. The Examiner has suggested without any support that the kit can be used for treating wounds. In other words, the Examiner stated that a kit comprising nicotine and substances that inhibit CYP2A activity or interfere with the coding of a gene encoding CYP2A can be used for treating wounds. The Examiner states that "Further, applicant is reminded of the extensive literature search which in involved in biotechnology application which is not co-extensive. Finally, applicant is reminded that a kit can be a device separation the different components, thus they would not have to be used 'contemporaneously' as is required in claim 22 and combination of the two components of the kit versus the separate components (given different times) may have different effects on the body that when administered together." Extensiveness of the literature is an insufficient reason not to meet the *prima facie* requirements for a restrictions. Furthermore, it appears that the Examiner is attempting to ignore the claim dependency and include limitations not present within the claim by defining the kit as something other than what is claimed. Because of the numerous unsubstantiated conclusory statements fail to meet the *prima facie* case for restriction,

Applicants maintain the impropriety of the restriction and respectfully request that claims 4-6, 19, and 22-24 be examined together.

Applicants maintain the traverse, and thus, have completely replied. MPEP §§ 821 and 821.01.

The Examiner has objected to the specification based on enumeration of the tables. Now, page 52, containing Table 1, has been renumbered to page 29a. This should overcome all objections by the Examiner that "Tables 2-5 appear in the specification before Table 1. Since this is not logically correct, it is object [sic] to in the instant specification."

Claims 22 and 23 stand rejected under 35 U.S.C. 103(a) as rendered obvious over U.S. patent No. 5,760,049 to N. Viner ("Viner") for the reasons set forth on pages 3 and 4 of the Office Action. Applicants respectfully traverse.

The consistent criterion for determination of obviousness is whether the prior art would have suggest to one of ordinary skill in the art that claimed subject matter should be carried out and would have a reasonable likelihood of success. *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). As the Examiner is well aware, in order to form a proper basis for a rejection under 35 U.S.C. § 103, the prior art must provide some suggestion, either explicit or implicit, of the combination that allegedly renders a claimed invention obvious. *M.P.E.P.*, § 2142 (June 1998), *see also, Panduit Corp. v. Denisson Manufacturing Co.*, 1 U.S.P.Q.2d 1593, 1597 (Fed. Cir. 1987). The Examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Sang Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002); citing *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The need for specificity is paramount, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed. *Id.* The Examiner's conclusory statements do not adequately address the issue of motivation to combine; the factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. *Id.*

Viner discloses an oral drug composition comprising an effective amount of (1) an acetylcholine receptor antagonist and (2) an acetylcholine esterase reactivator as well as a method for controlling tobacco use and alleviating withdrawal symptoms due to the cessation of tobacco use (col. 2, ll. 42-47). A class of compounds used as acetylcholine esterase

reactivators are oximes, generally defined by the formula $(R\text{-}CR{=}NOH)^{+}X^{-}$ (col. 3, ll. 7-9). In addition to the acetylcholine esterase reactivator and the acetylcholine receptor antagonist, it is within the scope of the present invention to co-administer additional compounds to assist in achieving the desired result or to provided additional cooperative treatment (col. 5, ll. 27-31).

The present claims are directed to methods for enhancing the effectiveness of nicotine replacement therapy in an individual in need of such treatment consisting essentially of: administering to an individual in need of nicotine replacement therapy a therapeutically effective amount of (a) nicotine; and (b) one or more substances selected from the group consisting of (i) substances which inhibit CYP2A activity; (ii) substances which inhibit transcription, and/or translation of the gene encoding CYP2A activity; and (iii) substances which delete all or a portion of the gene encoding CYP2A, wherein (a) and (b) are administered contemporaneously and (b) is administered in an amount of about 0.01 mg/kg to 80 mg/kg.

Viner fails to render the present claims obvious because Viner does not disclose or suggest the present method, and Viner teaches away from the present claims. The preamble of claim 22 recites a formulation consisting essentially of nicotine and substances which inhibit CYP2A activity. Additional materials may be added to the composition as long as the added materials do not materially affect the composition. Viner discloses a method of controlling tobacco and alleviating withdrawal symptoms due to cessation comprising administering an acetylcholine receptor antagonist and an acetylcholine esterase reactivator as active ingredients in a pharmaceutically acceptable solid matrix (claim 1). Contrary to the statements within the Office Action, claims 11 and 12 depend upon claim 10 which explicitly recites the administration of a stimulant **in conjunction with active ingredients**. Claims 11 and 12 recite as the **additional** stimulant nicotine pilocarpine and mixtures thereof, among others. Accordingly, Viner does not disclose or suggest a method comprising nicotine and substances which inhibit CYP2A activity, but a method which includes additional materials that materially affect the properties of the composition. Additionally, the materials direct the skilled artisan away from the present claims as Viner neither discloses not suggests the removal of the acetylcholine receptor antagonist and an acetylcholine esterase reactivator to obtain the present claims.

Accordingly, the rejection of claims 22 and 23 under 35 U.S.C. § 103(a) as rendered obvious by Viner cannot stand and should be withdrawn.

Accordingly, it is believed that claims 4-6, 19, 22-24, 35, and 36 are now in condition for allowance, early notice of which would be appreciated.

If any outstanding issues remain, the examiner is invited to telephone the undersigned at the telephone number indicated below to discuss the same. No fee is believed to be due for the submission of this response. Should any fees be required, please charge such fees to Brobeck, Phleger & Harrison, LLP Deposit Account No. 50-1640.

Respectfully submitted,

Dated: 9/27/02

By: _____
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EXHIBIT A
MARKED VERSION OF THE CLAIMS
U.S. PATENT APPLICATION SERIAL NO. 09/584.669

22. (Amended) A method for enhancing the effectiveness of nicotine replacement therapy in an individual in need of such treatment consisting essentially of: [comprising]

[contemporaneously] administering to an individual in need of nicotine replacement therapy a therapeutically effective amount of

(a) nicotine; and

(b) one or more substances selected from the group consisting of (i) substances which inhibit CYP2A activity; (ii) substances which inhibit transcription, and/or translation of the gene encoding CYP2A activity; and (iii) substances which delete all or a portion of the gene encoding CYP2A,

wherein (a) and (b) are administered contemporaneously and (b) is administered in an amount of about 0.01 mg/kg to 80 mg/kg.

23. A method according to claim 22 wherein said substance inhibits CYP2A6 and is methoxsalen, psoralen, tranylcypromine, pilocarpine, coumarin, chromone, esculetin, phenelzine, paroxetine, selegiline, or pargyline.

24. (Amended) A kit in the use in the method of claim 22 or 23 comprising (a) nicotine and (b) one or more substances selected from the group consisting of (i) substances which inhibit CYP2A activity; (ii) substances which inhibit transcription, translation of the gene encoding CYP2A, or both; and (iii) substances which delete all or a portion of the gene encoding CYP2A,

wherein (a) and (b) are administered contemporaneously.